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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/928,272	09/12/1997	MICHAEL J. ISKRA	P-3818	9434
7590		07/02/2008	EXAMINER	
RICHARD J RODRICK			MATTER, KRISTEN CLARETTE	
BECTON DICKINSON AND COMPANY			ART UNIT	PAPER NUMBER
1 BECTON DRIVE			3771	
FRANKLIN LAKES, NJ 074171880				

  

MAIL DATE	DELIVERY MODE
07/02/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	08/928,272	ISKRA, MICHAEL J.	
	<b>Examiner</b>	<b>Art Unit</b>	
	KRISTEN C. MATTER	3771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 28 January 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1 and 5-9 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1 and 5-9 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

This Action is in response to the amendment filed on 1/28/2008. No claims were amended, added or cancelled. Therefore, claims 1 and 5-9 are currently pending in the instant application. Following the pre-appeal conference on 3/20/2008, the finality of the Action mailed on 11/26/2007 has been withdrawn.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 6, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al. (US 3,706,306).

Regarding claim 1, Berger et al. discloses a one piece collection container assembly comprising an elongate tubular housing (19) having opposed first and second ends (see Figure 5), a solid partition (25) forming a closed bottom positions within said housing between the first and second ends (see Figure 5), said housing defining a volume for specimen collection and containment therein between said first end and said partition (column 3, lines 55-60), said second end forming a false bottom comprising a bottom end below said partition comprising an annular skirt (side walls of tube 19) and a semi-spherical bottom comprising an opening (at 38) therein (see column 5, lines 30-35). To the extent, if any, that a portion of the side walls of tube 19 cannot be considered to be part of said bottom end (i.e., because from Figure 5 it appears that the

bottom of tube 25 is in line with the semi-spherical bottom and the instant invention claims the "bottom end" must lie below said partition), examiner contends that it would have been obvious to one of ordinary skill in the art to decrease the length of blood sample tube 25 such that the rounded bottom of the tube was located higher than the spherical bottom of the outer tube 19 (so that the side walls of 19 could clearly be called an annular skirt included in the "bottom end") in order to decrease the volume of the blood sample tube without altering the outer dimensions of the container/syringe. In addition, it appears as though the device of Berger et al. would perform equally well with the length of the tube 25 being shorter than the straight portion of tube 19. See also *In re Rose*, 220 F.2d 459, 463, 105 USPQ 237, 240 (CCPA 1955), in which the court held that mere changes in size do not patentably distinguish an invention over the prior art.

Regarding claim 5, the partition disclosed by Berger et al. is arcuate in shape and has at least a partially rounded bottom portion (see Figure 5).

Regarding claim 6, the partition disclosed by Berger et al. can be considered conical (see Figure 5).

Regarding claim 9, Berger et al. is silent as to the dimensions of the container. However, absent a critical teaching and/or showing of unexpected results from making the container the claimed dimensions, examiner contends that it is an obvious design consideration to one of ordinary skill in the art to make the Berger et al. container the claimed dimensions because those dimensions are commonly used for blood/specimen collection containers. In addition, it appears as though the device of Berger et al. would perform equally well with the claimed dimensions. See also *In re Rose*, 220 F.2d 459, 463, 105 USPQ 237, 240 (CCPA 1955), in which the court held that mere changes in size do not patentably distinguish an invention over the prior art.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al. as applied to claim 1 above, and further in view of Burns (US 5,458,854). Berger et al. discloses that the container is made of synthetic plastic material (column 3, line 45) but does not specifically disclose the claimed thermoplastic polymers. However, Burns discloses, in a blood/specimen collection container, a tube made of the claimed thermoplastic polymers (column 5, lines 43-50) so that the specimen may be readily viewed. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have made the container of Berger et al. from the thermoplastic polymers of Burns in order to allow the sample to be readily viewed. In addition, it appears as though the device of Berger et al. would perform equally well if made of a thermoplastic polymer. See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960), in which the selection of a material known for its suitability for a given purpose does not patentably distinguish an invention over the prior art.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 and 5-9 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTEN C. MATTER whose telephone number is (571)272-5270. The examiner can normally be reached on Monday - Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kristen C. Matter/  
Examiner, Art Unit 3771

/Justine R Yu/  
Supervisory Patent Examiner, Art Unit 3771